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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,612	03/14/2002	Martin E. Davis	835-005.5-1	4343

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EXAMINER

MOHAMED, ABDEL A

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/099,612	DAVIS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Abdel A. Mohamed	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 March 2002.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### **ACKNOWLEDGMENT OF COMMUNICATION AND STATUS OF THE CLAIMS**

1. The communication filed 3/14/02 is acknowledged, entered and considered.

Claims 1-6 are present for examination.

### **CLAIMS REJECTION-35 U.S.C. § 112<sup>2nd</sup> PARAGRAPH**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-6, the full words for "GMP" should be used before the abbreviation, at least in the first occurrence.

Claims 1 and 2 are indefinite in the recitation the acronyms "DPW" and claims 3, 4 and 6 are indefinite in the recitation "SDS". Use of the full terminologies, respectively at least in the first occurrences would obviate this rejection.

### **CLAIM REJECTION-35 U.S.C. § 102(b)**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawasaki et al. (U.S. Patent No. 5,280,107).

The reference of Kawasaki et al. discloses a process of large scale production of low fat and SDS Gel pure kappa-casein GMP from bovine deproteinized whey, wherein the process involves processing of bovine whey by centrifuge, ion-exchanger or microfiltration/diafiltration to remove fat, whey protein and aggregate proteins to produce a deproteinized whey at acidic pH and then concentrating and drying the resultant GMP (See e.g., cols. 2-5) as directed to claims 1 and 2.

The reference applied the same techniques of a process for production of kappa-casein GMP by removing fat, whey proteins and aggregate proteins to obtain deproteinizing whey (DPW), concentrating the DPW, acidifying the concentrate from which protein has been removed, and contacting the acidified DPW by ion exchange resin to remove non-GMP peptides and proteins to obtain a resin effluent (See e.g., col. 2, lines 1-5 and col. 3, lines 20-27). On col. 2, lines 27 to 34, the reference discloses neutralizing the DPW protein obtained by ultrafiltration to recover the whey concentrates. On col. 3, lines 64 to col. 4, lines 13, the prior shows the removal of small quantities of casein curds and fatty contents, protein precipitates and lactose by centrifugation and ultrafiltration. Thus, the prior art discloses substantially the claimed process, and as such anticipates claims 1 and 2 as drafted.

4. Claims 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawasaki et al. (U.S. Patent No. 5,280,107).

The '107 patent of Kawasaki et al. discloses a product of glycomacropeptides (GMP) from bovine deproteinized whey having an SDS Gel high purity (See e.g., col. 2, lines 1-18) as directed to claims 3 and 4. Although, in Example 2, the reference shows purity of 87% as determined by SDS, however, high purity could mean up to 100% purity, and as such encompasses a GMP from bovine deproteinized whey having an SDS Gel purity of at least 91% or at least 95% as claimed in claims 3 and 4, respectively.

In regard to claims 5 and 6, the claims are in product-by-process format. The novelty and patentability of the claimed product is based on the claimed procedure and not on the recited process steps. Claims 5 and 6 recite (even as dependent on claims 1 or 2) no new novel properties based on the claims 1 or 2 recited processes. The cited reference teaches that the old product have been expected by one of ordinary skill in the art to have been highly purified by removing fat, whey protein, aggregate protein, lactose, small peptides and minerals to obtain a GMS product having an SDS Gel purity of at least 91% (See e.g., cols 2-5 and Examples 1 and 2). Thus, since claims 3 and 4 are product claims, and claims 5 and 6 are product-by-process claims, the prior art discloses the invention substantially as claimed, and as such anticipates claims 3-6 as drafted.

CONCLUSION AND FUTURE CORRESPONDENCE

5. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (571) 272-0955. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00 p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-7401 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

Abdel Mohamed/AAM

June 1, 2004